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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,895	10/15/2001	Cheol-Woong Lee	042933/253104	3472

826 7590 12/24/2008

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EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3685	

MAIL DATE	DELIVERY MODE
12/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/977,895	LEE ET AL.	
	Examiner	Art Unit	
	JOHN M. WINTER	3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 October 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-13,16 - 19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-13 and 16-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on October 2, 2008 is hereby acknowledged, Claims 11-13 and 16-19 remain pending.
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2008 has been entered.

Response to Arguments

3. Applicant's arguments with respect to the pending claims have been considered.

   The Examiner submits that the amended feature of "comparing a plurality of digital music files on the basis of file name, file size and file playing time;" is disclosed by Hale at Column 7, lines 46-50.

   The Examiner further states that Cooper et al. teaches determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network; (Paragraphs 74-77 – counts the number of downloads associate with unique ID on P2p network)

4. Claim Rejections - 35 USC § 101

5. Claims 11-13 and 16-19 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

   An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

   To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

   In this particular case, claims 11 and 12 fail prong (1) because the "tie" (e.g. distributing the media through a computer network) is representative of extra-solution activity.

Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hale et al., U.S. Patent No. 6,732,180 in view of Rabin et al., U.S. Patent No. 6,697,948 and further in view of Cooper et al. US Patent Application Publication 2001/0051996.

6. As per claims 11-13, Hale et al. teach identifying a digital music file, creating a deteriorated version of the music file and then distributing the deteriorated file (figure 3; column 8, lines 10-18; column/line 10/42-11/26).
comparing a plurality of digital music files on the basis of file name, file size and file playing time; (Column 7, lines 46-50)

However, Hale et al. do not specifically recite deteriorating the same file. Rabin et al. teach identifying a digital music file and then rendering the file unusable (column 15,

lines 49-60; column 26, lines 33-47). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hale et al. and Rabin et al. in order to prevent access to any clean versions of the digital music on the network.

Hale et al. do not specifically recite determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network; Cooper et al. teaches determining a digital music file that has a higher probability of being reproduced by another user than other music files related to the digital music file illegally distributed through a computer communication network; (Paragraphs 74-77 – counts the number of downloads associate with unique ID on P2p network). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Hale et al. and Cooper et al. in order to prevent access to any pirated versions of the digital music on the network ; furthermore the combination of these elements does not alter their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention..

As per claim 13, Hale et al. teach creating deteriorated versions of a digital music file by introducing white noise, degrading the quality of the file, inserting warnings and advertisements, or by other methods (column 8, lines 10-18). Hence, Hale et al. at least suggest to one of ordinary skill inserting a noise component (e.g. warning or ad) to create a deteriorated version of the file.

7. Claims 16-19 are not patentably distinct from claims 11-13 and are rejected for at least the same reasons, Examiner notes that the system disclosed by Cooper et al. relies upon a

8. unique digital ID for each distinct piece of content, therefore It would be obvious that the Cooper et al. reference could distinguish between different versions etc.. of the distributed content .

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685